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09/219,267	12/23/1998	JAY S. WALKER	WD-98109	2012

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EXAMINER

MYHRE, JAMES W

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/219,267

Applicant(s)
Walker et al

Examiner
James W. Myhre

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED-STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 19, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 23&24 6) ☐ Other:

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DETAILED ACTION

1. In view of the Appeal Brief filed on February 19, 2003, PROSECUTION IS HEREBY REOPENED. The new grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Response to Arguments

2. Applicant's arguments with respect to claims 1-64 have been considered but are moot in view of the new ground(s) of rejection.

Priority

3. The previous request for information still stands. As discussed in paragraph 1 of the May 14, 2001 action (paper number 15) and also during the December 11, 2001 interview (paper number 16) the Examiner cannot ascertain from the declaration or specification which one or

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more of the various inventors named in the nine prior applications invented which of the presently claimed features. Nor can the Examiner determine in which of the prior applications were each of the presently claimed features was first disclosed. Thus, the priority date of the present application cannot be determined. Therefore, the present application's filing date of December 23, 1998 is considered to be the priority date. During the December 11, 2001 interview, the Applicant Representative pointed out that since the references used to reject the claims pre-dated the earliest priority application, the priority date issue was mute.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 5-9, 15, 16, 18, 19, 42-45, 49, 51-54, 62, and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myhre (Examiner's Affidavit).

Claim 1: Myhre discloses a method for providing a discount to a customer which includes:

- a. Receiving an indication that a customer is to purchase an item from a merchant;
- b. Providing an offer (discount/subsidy) to the customer from a second merchant (manufacturer/advertiser/service provider) prior to the purchase transaction being completed;

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- c. Receiving a response from the customer accepting the offer; and
- d. Applying the benefit (discount/subsidy) to the item.

The Examiner notes that Radio Shack would “present a list of service plans offered by Sprint with their costs and the amount of discount each would bring on the current purchase of the cell phone” once the customer indicated his desire to purchase the cell phone (steps a and b above). If the customer accepted the subsidy offer and completed the Sprint service application form, the discount on the cell phone purchase would be given upon receipt of an approval code from Sprint (steps c and d above). Each of the service plans had various rules which delineated the qualifications needed to be met by the customer and/or cell phone before it was a viable offerable option, e.g. subsidy based on length or terms of service contract, cost of phone, age or other demographics of the customer, etc.

While Myhre does not explicitly disclose that the customer is conducting the transaction on the merchant’s web site, Official Notice is taken that it is old and well known within the retail arts for merchants to conduct business and sell a myriad of products, to include cellular telephones, on the Internet through web sites. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to update the circa 1990 Radio Shack system to sell products via an online web site. One would have been motivated to sell products via a web site in order to reach a far wider range of customers. This is the basic reason so many companies have migrated at least part of their product sales to the Internet in the past 10-12 years.

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Claim 2: Myhre discloses the method as in Claim 1 above, and further discloses receiving customer information (via the Sprint service application form).

Claims 5 and 45: Myhre discloses the method as in Claims 1 and 2 above, but does not explicitly disclose that the offer is from a second merchant who has been selected from a plurality of merchants based on the customer information. However, Logan discloses a similar method and further discloses providing an offer from a second merchant selected from a plurality of merchants based on the customer information (col 9, lines 23-50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use customer information, such as an indicated preference for a service provider (e.g. Sprint or AT&T), to present an offer to the Radio Shack customer. One would have been motivated to select the offer from a plurality of secondary merchants in order to give the customer greater latitude in the selection of service plans and providers, thus increasing the likelihood that the customer would accept the offer. If, for instance, the customer had several bad experiences with AT&T in the past, there would be little incentive, and probably much disincentive, for the customer to accept the subsidy offer if it bound him to a year-long service contract with AT&T.

Claim 6: Myhre disclose the method as in Claim 2 above, and further discloses providing an offer based on the customer information (indication of willingness to purchase the cell phone).

Claim 7: Myhre discloses the method as in Claim 2 above, and further discloses requesting and receiving customer information from the customer (completing the Sprint service application form).

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Claims 8 and 9: Myhre discloses the method as in Claim 7 above, and further discloses transmitting a question to the customer and receiving the customer's answer (inherent in application forms).

Claims 15 and 16: Myhre discloses the method as in Claim 2 above, and further discloses providing the offer after receiving and based upon the customer information (indication of willingness to purchase the cell phone).

Claim 18: Myhre discloses the method as in Claim 2 above, and further discloses that the customer information includes the location or Internet address of the customer (customer address on the application form).

Claims 19, 51, and 54: Myhre discloses the method as in Claim 1 above, and further discloses that the benefit is a reduced price (discount) for the item (subsidized price).

Claim 42: Myhre disclose the method as in Claim 1 above, and further discloses providing the offer only when a predetermined rule is satisfied (customer indicates willingness to purchase the cell phone).

Claims 43 and 44: Myhre discloses the method as in Claim 1 above, and further discloses provide a plurality of offers from the merchant ("list of service plans") and receiving an indication of a selected offer from the customer.

Claims 49 and 53: Myhre discloses the method as in Claims 1 and 51 above, and further discloses receiving a payment from the second merchant upon acceptance of the offer ("Sprint would reimburse Radio Shack").

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Claims 52 and 64: Myhre discloses the method as in Claim 51 above, and further discloses charging the amount, based on the difference between total price and price charged, to the customer, but does not explicitly disclose that it is charged to the customer's credit card. Official Notice is taken that it is old and well known within the retail arts for customers to make purchases using credit cards. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the Radio Shack customer to credit the purchase price to a credit card account. One would have been motivated to charge the purchase price to a credit card account in order to eliminate the need for handling large amounts of cash by the customer and merchant.

Claim 62: Myhre discloses the method of Claim 1 above, but does not explicitly disclose that the customer can interact with the system via a customer interface. However, Logan discloses a similar method, and further discloses generating a customer interface for allowing the customer to interact with the system (col 10, lines 51-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to allow the Radio Shack customer to interact with the system via a customer interface. One would have been motivated to use such a customer interface to facilitate completion of the application form by the customer, thus eliminating the need to use a facsimile machine to send the completed form to Sprint.

6. Claims 10-14, 29-32, 55-61, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myhre (Examiner's Affidavit).

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Claim 10: Myhre discloses the method as in Claim 2 above, but does not disclose verifying the accuracy of the customer information. Official Notice is taken that it is old and well known within the information arts to verify incoming data, such as customer information (see col 9, lines 9-14 of Woolston, 5,845,265, submitted by Applicant as item EE on the Information Disclosure Statement filed on May 19, 1999, paper number 5, as support for this Official Notice).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to verify the customer information upon receipt. One would have been motivated to verify the accuracy of the information in order to ensure the database is kept as up-to-date and as accurate as possible and to facilitate the approval process by Sprint. If incorrect customer information has been entered on the application form, such as a misspelled name, it may be impossible for Sprint to complete a credit check and issue an approval of the application.

Claims 11-13: Myhre discloses the method as in Claim 10 above, but does not disclose assessing a penalty if the customer information is not accurate. Official Notice is taken that it is old and well known within the information arts to penalize users when the entered information, such as log-in and password information, is not accurate. It is also well known that this penalty may take many forms, such as monetary, denial of service, disconnection, etc. (see col 4, lines 33-39 of Baker et al, 5,884,292, submitted by Applicant as item FF on the Information Disclosure Statement filed on May 19, 1999, paper number 5, as support for this Official Notice). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to penalize the customer for inaccurate information. One would have been motivate to

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penalize the customer in one of these manners in order to ensure the accuracy of the information retained in the database and to enforce any limitations on the benefit, such as the number of times a customer may receive the benefit within a specified time period, etc. Myhre implies such a penalty when Sprint returns a non-approval (rejection) of the application form, thus preventing the customer from not only receiving the benefit, but also from being able to activate the cell phone at the time of purchase (unless another service provider approves a secondary offer to the customer).

Claim 14: Myhre discloses the method as in Claim 10 above, but does not disclose verifying the information prior to consummating the purchase. Official Notice is taken that it is old and well known and would have been obvious to one having ordinary skill in the art at the time the invention was made to verify the customer information prior to processing the transaction (see col 4, lines 33-39 of Baker et al, 5,884,292, submitted by Applicant as item FF on the Information Disclosure Statement filed on May 19, 1999, paper number 5, as support for this Official Notice). One would have been motivated to ensure this prior to completing the transaction in order to prevent entry of fraudulent or inaccurate information into the database, to ensure the purchased item is delivered to the correct address, and to ensure that the credit card data is correct prior to releasing the merchandise to the customer.

Claims 29-32: Myhre discloses the method as in Claim 1 above, and further discloses requesting the customer to participate in a transaction with a second merchant (signing a service

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contract), receiving an indication from the customer agreeing to such participation, and that the agreement is to initiate a service contract with the second merchant.

Claim 55: Myhre discloses the method as in Claims 1 and 29 above, but does not disclose canceling the second transaction upon receipt of a revocation of the acceptance from the customer. Official Notice is taken that it is old and well known within the marketing arts that transaction can be canceled or retracted by the customer prior to completion of the purchase (see col 12, line 58 - col 13, line 8 in Huberman, 5,826,244, submitted by the Applicant as item DD on the Information Disclosure Statement filed on May 19, 1999, as support for this Official Notice). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to cancel the transaction upon receiving a revocation of the acceptance from the customer. One would have been motivate to cancel the transaction in order to provide better customer service and to preclude erroneous shipping of the item to a customer who does not want it.

Claims 56-60 and 63: Myhre discloses the method as in Claim 1 above, and discloses transmitting a form to the customer who completed the form and returns it to the system. However, Myhre does not disclose that the offer is a discount based on the customer's application for a credit card, nor that the customer completes and submits an application form online after the system determines that the customer does not already have another credit card account with the credit card issuer. Official Notice is taken that it is old and well known within the marketing arts to make promotional offers to customers who will complete and submit application forms for

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credit cards (see the Times Newspaper article by Stephen Ellis, "Credit card forms drive down costs", submitted by Applicant as item GG on the Information Disclosure Statement filed on May 19, 1999, paper number 5, which is cited in support of this Official Notice). These offers are not only made at a merchant's point of sale, but are prevalent throughout our "plastic" society. Indeed, with the advent of "sponsored" credit cards several years ago, such as banks and even gasoline companies issuing VISA cards, surveys have shown that each American receives dozens of such offers each year. Indeed, even Radio Shack offered its own brand of credit card and included a percentage discount on your first purchase with it. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a promotion based on a credit card application by the customer. One would have been motivated to use such a promotion in order to increase the amount of credit available to the customer, thus enticing the customer to spend more at the merchant. One would have been motivated to ensure that the customer did not already have an account with the credit card issuer in order to avoid providing an excessive credit limit to a customer.

Claim 61: Myhre discloses the method as in Claim 1 above and further discloses the second merchant (service provider) providing offers targeted to the specific customer, but does not explicitly disclose sending the customer information to the second merchant prior to receiving the targeted offer. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the second merchant would require the customer information in order to provide an offer targeted to that customer. Therefore, Myhre's disclosure of providing

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targeted offers from the second merchant infers that the customer information has been received by the second merchant prior to selection of the offer. One would have been motivated to provide the customer information after receiving the indication that the customer is willing to purchase an item in order to allow new customers, whose information was just being collected, to participate in the customized offer system.

7. Claims 3, 4, 17, and 33-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myhre (Examiner's Affidavit) in view of Saxe (5,636,346).

Claims 3, 4, and 33: Myhre discloses the method as in Claim 2 above, but does not disclose that the customer information includes a service or service provider. Saxe discloses a similar method in which the customer information includes the customer's "cable account numbers and cable system identification numbers" (col 4, lines 18-27). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include information about Myhre's customer's service and service provider. One would have been motivated to include this information in order to increase the accuracy and utility of the customer information database when used for marketing programs, such as Sprint presenting special offers to new customer if they switch their other telephone services (local and/or long distance) to Sprint.

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Claim 17: Myhre discloses the method as in Claim 1 above, but does not disclose receiving the customer information from a third party. Saxe discloses a similar method which receives the customer information either directly from the customer as Myhre discloses, or from "third party demographic sources" (col 6, lines 39-48), etc. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to obtain at least part of Myhre's customer information from third party sources. One would have been motivated to obtain the information in this way in order to further expand the information in the database without requiring the customer to enter a large amount of data.

Claims 34-40: Myhre discloses the method as in Claim 1 above, and Saxe discloses determining the service provider of the customer as in Claim 33 above. However, neither reference discloses the steps involved in changing the customer to the new service provider upon receiving an indication of accepting such a change from the customer. Official Notice is taken that it is old and well known within the art to provide promotional offers for customers to switch from one service provider to another (i.e. AOL vs Prodigy vs Compuserve, etc.)(see page 2 of Stephen Ellis, "Credit Cards Firms Drive Down Costs", submitted by the Applicant as item GG on the Information Disclosure Statement filed on May 19, 1999, paper number 5, as support for this Official Notice). It is also well known that one will normally cancel any existing service agreement with another service provider when initiating a new service agreement with the second service provider (such as when switching long distance telephone service providers). It is also well known to check the second service provider's customer database to ensure that the requestor

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is not already a customer. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the second service provider to check for duplicate membership, to initiate a new service contract with the customer if not a duplicate, and to cancel any existing service contract with the other services providers. One would have been motivated to perform these steps in order to prevent duplication of services being provided to the customer.

8. Claims 20-28, 41, 46-48, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myhre (Examiner's Affidavit) in view of Weinblatt (5,515,270).

Claims 20-28: Myhre discloses the method as in Claim 19 above, but does not disclose that the price is reduced by a predetermined amount or percentage or reduced to zero (free item) or that the reduction is taken if the price of the item is greater than the reduction amount. Weinblatt discloses a similar method in which the promotions (offers) "can involve coupons for lowering the price"... "2 for 1 sale, oversize containers sold for the same price, manufacturer rebates, combining one product with another product, free giveaways, eligibility for a prize drawing, etc." (col 8, lines 40-45), Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that various types of offers could be utilized, to include price reductions based on a predetermined amount, a predetermined percentage, reduction of the price to zero (free giveaway), etc. It also would have been obvious to limit the reduction to no more than the total price of the item being purchased. One would have been motivated to include these types of price reduction offers and to place such a limit on the reduction in order to

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increase the flexibility of the system while preventing the merchant from losing money by actually paying the customer to take the item (if the price reduction exceeded the price of the item).

Claims 41, 46, 47, and 50: Myhre discloses the method as in Claim 1 above, but does not disclose that the offer is made only if the price of the item is greater than a predetermined threshold. Weinblatt discloses a similar method in which the offer (reward) is based on the purchase parameters, such as number of items, item cost, category of item, etc. (col 13, line 11 - col 14, line 19). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to base the offer on various parameters of the purchase information. One would have been motivated to use the price of the item or total payment amount in order to present offers customized to the purchase to increase the likelihood that the customer will accept the offer.

Claim 48: Myhre discloses the method of Claim 1 above, and Weinblatt discloses basing the offer on the item as in Claims 41, 46, 47, and 50 above. Weinblatt also discloses that the advertiser will select the offer (col 13, line 11 - col 14, line 19). This infers that the advertiser is selecting the offer from a plurality of such offers (i.e. if the advertiser only had one offer, there would be no need to make a selection). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select the offer from a plurality of offers. One would have been motivated to have a plurality of offers available in order to increase the range of customers and offers with matching parameters.

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Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In support of the Examiner's Affidavit used in the rejection above, the Examiner has enclosed several other references to show the widespread use of subsidies by service providers to incent customers at a merchant location (physical or virtual) to purchase cellular telephones, cable modems, etc. throughout the past ten years.

A. Dent (5,666,649) discloses in the background section of the specification that "service providers offer a subsidy to the retail outlet on more expensive telephones".

B. Cooper (5,673,317) discloses in the background section of the specification that "many service providers and carriers have begun subsidizing the sales price of wireless network access devices to potential customers, requiring in turn that the subsidized device will be activated on and exclusively use their services for at least a certain minimum period of time" and that "many subsidizing providers and carriers therefore require immediate activation of the device with their service before the customer leaves the store".

C. Radio Shack (<http://www.radioshack.com/Partners/Verizon/VerizonLanding.asp>) discloses that the method for selling and subsidizing cellular telephones as disclosed in the Examiner's Affidavit above is still in use by Radio Shack and has been updated to use personal computer systems online instead of facsimile machines and telephones.

D. Buy.com (<http://www.buy.com/retail/w...Category=CELLULAR>) discloses that the method of selling and subsidizing cellular telephones is being used throughout the industry. It

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also discloses that the customer can "activate any AT&T Wireless phone with a 12-month subscription on or before April 30, 2003 and get a \$19.99 eCoupon good on a future buy.com DVD purchase of your choice" which shows the customer receiving a benefit (discount coupon) on an item other than the cellular telephone being purchased. The same offer discloses that the offer is only for a limited amount of time, and also that the benefit must be used within a predetermined period of time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:30 a.m. to 3:30 p.m.

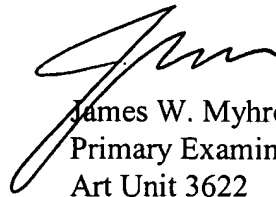
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9326. Draft or Informal faxes may be submitted to (703) 872-9327 or directly to the examiner at (703) 746-5544.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM

April 15, 2003



James W. Myhre
Primary Examiner
Art Unit 3622